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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,707	06/28/2000	KLAS HYLLANDER	2867-0180-6	9794

22850 7590 09/18/2003

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1940 DUKE STREET
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EXAMINER

NGUYEN, SIMON

ART UNIT	PAPER NUMBER
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2685

DATE MAILED: 09/18/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/485,707

Applicant(s)

HYLLANDER ET AL.

Examiner

SIMON D NGUYEN

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35-38 is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,4,9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 17-18, and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Coiera et al. (5,949,866).

Regarding claim 1, Coiera discloses a communication system for establish connections to and between internet users, wherein the communication system includes a cellular radio communication network adapted to provide a short message service, a server for facilitating the establishment of a telephony/internet connection between a mobile station and an Internet user, and in that the SMS is used to transfer (fig.1, column 2 line 36, column 4 lines 49-54), comprising: from the mobile station to the server, information identifying the Internet address for the Internet user; and from the server to the mobile station, information relating the connection between the mobile station and the Internet user (column 2 line 36, column 4 line 49 to column 5 line 42).

Regarding claim 18, this claim is rejected for the same reason as set forth in claim 1.

Regarding claims 17 and 34, Coiera discloses the system as a GSM system (column 3 lines 49-50).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-11 and 19-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coiera et al. (5,949,866) in view of Xu et al. (6,151,628).

Regarding claims 2-3 and 19-20, Coiera further discloses the Internet address for an Internet connected computer terminal (server 1) of the Internet user (e.g., role identifiers) (fig.1, column 2 line 36, column 4 lines 49-60). However, Coiera does not specifically disclose a specific identity for the mobile station.

Xu discloses an Internet communication system in which a specific identity for a mobile station is a telephone number (column 5 line 64 to column 6 line 1). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modified the Coiera system with the teaching of Xu in order to inform a called station that is making the call.

Regarding claims 4 and 21, Coiera further discloses the server analyzing the SMS information for identifying the mobile station (column 4 line 54 to column 5 line 15).

Regarding claims 5-7 and 22-24, Coiera further discloses the step of responding to receipt of the SMS information from the mobile station, to send an SMS to the mobile station (column 4 line 65 to column 5 line 28). However, Coiera does not specifically disclose the step of the steps of: determining whether the call connection to the Internet user is possible; identifying the calling party; associate the telephone call with the Internet address and connect the call; analyze by the server to identify the mobile station.

Xu discloses the Internet access for mobile terminals wherein a server (#20 of fig.1) determines whether the call connection to the Internet user is possible (column 6 lines 13-37), identifies the calling party, associates the call with the Internet address and connects the call to a called party (column 5 line 61 to column 6 line 57, column 9 lines 35-47), and analyze to identify the mobile station by the server (communication chassis #20 of fig.1(column 11 lines 26-64). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the Coiera system with the teaching of Xu to improve the connection in the system in order to prevent the fraudulent.

Regarding claims 8 and 25, Coiera further discloses the system monitoring the mobile station for a specific period of time (column 5 lines 29-43).

Regarding claims 9-10 and 26-27, Coiera further discloses the call directly connecting to the Internet address (column 2 lines 30-36). However, Coiera does not specifically disclose at least one additional Internet server.

Xu discloses the Internet access for mobile terminals having a plurality of additional Internet servers (#30, 34 of fig.1) for providing Internet telephone services. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the Coiera system with the teaching of Xu to give more flexibility in the ability of Internet service provider in order to serve diverse Internet users.

Regarding claims 11 and 28, Coiera further discloses the server having a database for storing records of subscribers (column 5 lines 29-42) wherein the records of subscribers including internet addresses of the subscribers (column 2 line 36).

5. Claims 12-13, 15-16, 29-30, and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coiera et al. (5,949,866) in view of Xu et al. (6,151,628) as applied to claims 1, 18 above, and further in view of White et al. (6,014,379).

Regarding claims 12-13 and 29-30, these claims are rejected for the same reason as set forth in claim 5, wherein the server includes a database for storing the Internet addresses (column 2 line 36, column 5 lines 29-42). However, the modified Coiera system does not specifically disclose the server storing address numbers in respective mobile stations' telephone numbers.

White discloses an Internet phone in which a server (#32 of fig.1) having a database for storing address numbers in respective mobile stations' telephone numbers (column 7 lines 41-58). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the modified Coiera system with the teaching

of White to give more flexibility in the ability of Internet service provider in order to serve diverse Internet users.

Regarding claims 15 and 32, Coiera further discloses the server searches for a specific one of the Internet address (column 4 line 49 to column 5 lines 15).

Regarding claims 16 and 33, these claims are rejected for the same reason as set forth in claim 12, wherein the unlisted address requested by the mobile station is obvious to be sent to the mobile station.

6. Claims 14 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coiera et al. (5,949,866) in view of Xu et al. (6,151,628) as applied to claims 11, 28 above, and further in view of Dussell et al. (5,938,721).

Regarding claims 14 and 31, the modified Coiera system fails to teach the mobile storing a list of addresses.

Dussell discloses a communication system in which a PDA as a mobile device stores address lists (column 1 lines 11-20). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the modified Coiera system with the teaching of Dussell in order to help the user in case of forgetting the address number to dial.

Allowable Subject Matter

7. Claims 35-38 are allowed.

Regarding claims 35 and 36, the prior art of record does not specifically disclose in sequence steps as claimed.

Regarding claims 37-38, these claims are allowed as being dependent upon independent claim that has been allowed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon Nguyen whose telephone number is (703) 308-1116. The examiner can normally be reached on Monday-Friday from 7:00 AM to 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward F. Urban, can be reached on (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-0377.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Hand-delivered response should be brought to Crystal Park II,
2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

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Simon Nguyen

September 9, 2003

Simon Nguyen